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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,992	12/17/2001	Yasushi Kurakake	393032029200	4246

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EXAMINER

GECKIL, MEHMET B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,992

Applicant(s)

KURAKAKE ET AL.

Examiner

Mehmet B. Geckil

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-14 are presented for examination.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The claimed invention recited in claims 13-14 is directed to non-statutory subject matter. Claims 13-14 is rejected because it recites a program not embodied in a computer readable medium and therefore it is non-statutory subject matter. In order to overcome this rejection applicant may amend the claim to recite that the program is embedded in a computer readable medium and executed by a computer processor to perform the steps of the program.

4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1,2,8,and 13-14, the phrase "thereby" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office argument:

Art Unit: 2142

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al.

7. Hunt et al (5,893,091) taught the invention substantially as claimed including a method of searching for contents information presented by a plurality of information sites or Timely Information Providers (see Abstract) over a network based on a query sent from a client terminal to a searching server through the network, the method comprising the computer-implemented steps of:

- a) registering information sites which present contents information involving various keywords and arguments related to each other (col 5, line 5 et seq);
- b) initiating the client terminal to transmit a query to the searching server through the network, the query containing a keyword indicating the keyword as a target of searching and an argument indicating an argument to be made on the keyword (col 5, line 25 et seq);
- c) operating the searching server according to the query to search for one or more of the registered information sites having contents information matching the query, and to send back directory information indicative of locations of the searched information sites to the client terminal; and operating the client terminal according to the directory

information for accessing the searched information sites, thereby enabling a user to make the argument on the keyword (col 5, line 45 et seq).

8. It would have been obvious to one of ordinary skill in the network search systems that the claimed invention differed from the teachings of Hunt et al only by a degree, e.g., in the claimed action versus the argument teaching of Hunt et al for the alerts. But this is no more than a degree in a difference because claimed action is associated with a keyword and in Hunt et al arguments are associated with the keyword for generating alerts. Other claimed features are all obvious variations of the well known features of the search engines. For example, Hunt et al teaches using alerts for purchase of merchandise for sale (see col 6, line 33 et seq.) Applicant's claimed invention uses actions for making an action on the item or merchandise. Therefore it only differs by a degree. Using index tables are well known in the database querying art for a long time by now (see for example U.S. Patent No 6,424,980 for a keyword index which is registered in advance.) Applicant should also note and amend claims accordingly in view of the European search report indicating an X (102 in US system) reference rejection based on Sandro Pasquali reference (WO0057293).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nagatomo et al (6,334,126) taught registering keywords in the information provider table (see col 19 and Figure 18.)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (571) 272-3894. The examiner can normally be reached on Monday through Friday from 6:30 A.M. to 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Jack Harvey, can be reached on (571) 272-3896.

The fax phone number for the organization where this application or proceeding is assigned is **(703) 872-9306**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 305-3800/4700**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/16/05



MEHMET B. GECKIL
PRIMARY EXAMINER